

**REMARKS**

Applicant respectfully acknowledges receipt of the Office Action mailed March 30, 2006.

In the Office Action, the Examiner: (1) rejected claims 1-6, 8, 9, 12-14, and 17-19 under 35 U.S.C. § 102(b) as being anticipated by *Kurz* (U.S. Patent No. 5,146,931); (2) rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over *Kurz*; and (3) objected to claim 7 as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

By this Amendment, Applicant proposes to amend claims 1-9, 11-14, and 17-19 to better define the claimed invention and correct informalities. After entry of this Amendment, claims 1-9, 11-14, and 17-19 will remain pending. Of these claims, claim 1 is independent. Claims 10, 15, and 16 were previously canceled, without prejudice or disclaimer, in the "Amendment After Final" filed February 16, 2005.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 1-9, 11-14, and 17-19. No new matter has been introduced.

Applicant gratefully acknowledges the Examiner's indication of allowable subject matter in claim 7. However, Applicant has not rewritten claim 7 to include all of the limitations of the base claim and any intervening claims because at least independent claim 1 is patentably distinguishable over the cited prior art.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

**I. 35 U.S.C. § 102(b) REJECTION**

Claims 1-6, 8, 9, 12-14, and 17-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Kurz*. Applicant respectfully disagrees with the Examiner's arguments and conclusions and submits that independent claim 1 is patentably distinguishable over *Kurz* at least for the reasons set forth below.

In order to properly establish that *Kurz* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be disclosed, either expressly or under principles of inherency, in that single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

*Kurz* discloses a device placed in a uterus, wherein the device includes a copper wire 10 wound around a stem 1 for introducing copper ions into the uterus during a lengthy period. (*Kurz*, col. 4, ll. 16-20). The copper wire 10, which is impregnated with a desired agent, can also be wound around arm parts 4 and 5 of the device. (*Id.* at col. 4, ll. 21-29).

*Kurz*, however, fails to teach or suggest wherein each of the arm parts 4 and 5 of the device is capable of receiving and releasing a separate pod, which is capable of releasing a substance into the body cavity (emphasis added). The Examiner alleges that "[t]he *Kurz* reference discloses...[a] releasably receivable substance delivery means ([i.e.,] the wound copper wire on the arms, see col. 4, lines 20-29)..." (*Office Action*, page 2). However, as defined by the *Wikipedia Encyclopedia*, a pod is "a term used in the vernacular to mean: body, capsule, case,...and the like." (*Wikipedia*

*Encyclopedia*, [www.wikipedia.com](http://www.wikipedia.com)). Accordingly, a person of ordinary skill in the art would not consider the “wound copper wire” to satisfy the definition of a “pod” as described above and recited in amended claims 1 and 4-8.

Accordingly, with respect to independent claim 1, *Kurz* fails to teach or suggest the claimed combination, including, *inter alia*:

“wherein each resilient arm is capable of receiving and releasing a separate pod capable of releasing a substance into the body cavity” (emphasis added).

The Examiner, therefore, has not met the essential criteria for showing anticipation, wherein “each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in...a...single reference.” See M.P.E.P. § 2131. Accordingly, independent claim 1 is patentable over *Kurz*. Applicant therefore requests that the rejection of claim 1 under 35 U.S.C. § 102(b) be withdrawn and claim 1 be allowed.

Moreover, claims 2-6, 8, 9, 12-14, and 17-19 are allowable at least due to their dependence from independent claim 1. In addition, at least some of the dependent claims may recite unique combinations that are neither disclosed nor suggested by the cited art, and therefore some also are separately patentable.

## **II. 35 U.S.C. § 103(a) REJECTION**

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kurz*. As noted above, with respect to independent claim 1, *Kurz* fails to teach or suggest the claimed combination, including, *inter alia*:

“wherein each resilient arm is capable of receiving and releasing a separate pod capable of releasing a substance into the body cavity” (emphasis added).

Accordingly, claim 11 is in condition for allowance at least due to its indirect dependence from allowable claim 1. Consequently, Applicant respectfully requests that the rejection of claim 11 under 35 U.S.C. § 103(a) be withdrawn.

### **III. CONCLUSION**

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-9, 11-14, and 17-19 in condition for allowance. Applicant submits that the proposed amendments of claims 1-9, 11-14, and 17-19 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this

Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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